

Attorney Docket No.: **SJ-0011**  
Inventors: **Danks et al.**  
Serial No.: **09/622,568**  
Filing Date: **August 31, 2000**  
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#### **REMARKS**

Claims 23-31 are pending in the instant application. The pending claims have been subjected to a Restriction Requirement as follows:

Group I, claims 23, 25, 27-29 drawn to a method of activating a prodrug by administering a carboxylesterase.

Group II, claims 24-27 and 30-31, drawn to a method of activating a prodrug by administering a nucleic acid encoding a carboxylesterase.

The Examiner suggests that Groups I and II as set forth above are distinct, each from the other, because they do not share any corresponding special technical features as defined in PCT Rule 13.2. Applicants respectfully traverse this restriction requirement.

MPEP §803 is quite clear; for a proper restriction requirement, it must be shown (1) that the inventions are independent or distinct AND (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate

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manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

All of claims of the instant application relate to the single concept of activating a prodrug by administering a carboxylesterase. Accordingly, each of the claims contain the components for use in the same endpoint, namely activation of a prodrug due to administration of the carboxylesterase. Thus, Applicants respectfully disagree that the Groups set forth by the Examiner are distinct as being novel and unobvious over each other, as required by MPEP § 802.01.

Further, a search of literature relating to carboxylesterase-activated prodrugs would clearly reveal art relating to both of these Groups. Thus, the inclusion of both Groups in this application would not be overly burdensome to the Examiner. Accordingly, the instant Restriction Requirement meets neither of the criteria as set forth by MPEP §803 to be proper. Reconsideration and withdrawal of this Restriction Requirement is therefore respectfully requested.

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However, in an earnest effort to be completely responsive,  
Applicants elect Group 1, claims 23, 25, and 27-29 with traverse.

Respectfully submitted,

*Jane Massey Licata*

Jane Massey Licata  
Registration No. 32,257

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Licata & Tyrrell P.C.  
66 E. Main Street  
Marlton, New Jersey 08053

(856) 810-1515